

O-404-11

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2419729
BY MERYL J SQUIRES TO REGISTER THE TRADE MARK**

DEEP RELEEV

IN CLASS 5

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 97825 BY THE MENTHOLATUM COMPANY LIMITED**

BACKGROUND

1. On 19 April 2006, Meryl J Squires (“Squires”) applied to register **DEEP RELEEV** as a trade mark for the following goods in class 5:

Medicinal herbal extracts; and medical infusion.

Following examination, the application was accepted and published for opposition purposes on 20 June 2008.

2. On 28 August 2008, The Mentholatum Company Limited (“Company”) filed a notice of opposition. This consisted of a single ground based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Company’s opposition is directed against all of the goods in Squires’ application.

3. In response to the following question which appears in box 5 of the Notice of opposition:

“Are there any related proceedings currently with the Registry or the courts? If so, give application, registration or opposition number”

Company said:

“Yes – a cancellation action was filed by the applicant against the opponent’s CTM Reg No. 259077. A decision has been issued by the OHIM and the deadline for appeal was 20/8/08. The opponent did not appeal and we have not been notified of an appeal by the applicant so far. The decision limited the specification to [that shown in paragraph 4 below].”

4. In these proceedings Company relies upon the following trade mark:

Trade Mark	No.	Application date	Registration date	Goods
DEEP RELIEF	259077 CTM	09.05.1996	05.02.1999	Pharmaceutical or veterinary products for pain relief.

Company indicates that its trade mark has been used upon all of the goods mentioned above.

5. On 1 September 2009, Squires filed a counterstatement in which it said, inter alia:

“...the applicant’s mark is not confusingly similar to that which is the subject of the opponent’s registration, and the goods are not the same or similar to those of concern to the opponent.”

In addition, I note that Squires put Company to proof of use.

6. Only Company filed evidence. Neither party asked to be heard nor did they file written submissions in lieu of attendance at a hearing.

EVIDENCE

7. This consist of a witness statement, dated 16 February 2011, from Douglas Smart, Company's Finance Director and Company Secretary. Mr Smart states that the trade mark DEEP RELIEF has been in continuous use since it was first introduced in 1994. He goes on to say that the trade mark is used in relation to pharmaceutical products for pain relief, adding that while the product was originally manufactured in Australia and imported in to the UK, it has been continuously manufactured in the UK since 1996.

8. The wholesale value of sales of DEEP RELIEF products within the UK have been as follows:

Year	Wholesale – (£)
2001	688,045
2002	790,398
2003	825,646
2004	780,987
2005	649,693
2006	702,976
2007	750,018
2008	658,620

9. Company have spent the following sums promoting the DEEP RELIEF product within the European Union:

Year	Advertising and promotion – (£)
2001	236,939
2002	125,900
2003	228,394
2004	241,857
2005	212,487
2006	145,683
2007	173,234
2008	93,275

10. Mr Smart explains that products bearing the DEEP RELIEF trade mark have been sold in the UK through "major UK retailers" such as Boots and Superdrug (chemists) and Sainsbury's (supermarket). Exhibit DS1 consists of electronic copies of three invoices. All three invoices indicate that the goods listed were sold and shipped to Boehringer Ingelheim at an address in Bracknell, Berkshire. The first invoice, dated, 29 September 2006, contains a reference to "Boots Account." On the first page of the 4 page invoice there is an entry which reads: "DEEP RELIEF 50G DOMESTIC" and relates to a quantity of 3600 amounting to £6,879.60. The second invoice, dated 30

June 2005, contains a reference to Superdrug. The first page of this invoice contains the same entry mentioned above and relates to a quantity of 2448 amounting to £5,459.04 The third invoice, dated, 31 August 2004, contains a reference to Sainsbury. The first page contains the entry mentioned above and relates to a quantity of 5400 amounting to £10,665.00.

11. Mr Smart goes on to say that the DEEP RELIEF product has been advertised and promoted through advertisements in newspapers and magazines, money-off coupons, in-store promotions and media advertising. Exhibit DS2 contains a list of publications (created it appears by an undertaking called Acumen) in which the DEEP RELIEF trade mark has been promoted between May 2003 and March 2007, together with examples of the trade mark in use on money-off vouchers from June 2003 (in a publication entitled "My Weekly" the front page of which contains a reference to "Can. \$3.75"), from June 2004 (in a publication entitled "The People's Friend" which contains a reference to "63p") and on a money-off voucher from May 2006. In this material the trade mark DEEP RELIEF appears, inter alia, in the form in which it stands registered i.e. in upper case and is described in the following ways:

"DEEP RELIEF

NO OTHER GELS WORKS LIKE IT"

And:

"Deep Relief – for the relief of muscular aches and pains."

"No other formula works faster, lasts longer than Deep Relief. So change to Deep Relief if muscular aches and pains, backache, rheumatism or every day arthritic pain is slowing you down. Try Deep Relief and you will notice the difference."

12. Mr Smart concludes his statement in the following terms:

"9. The mark applied for, DEEP RELEEV, is visually, phonetically and conceptually very close to my company's mark DEEP RELIEF. The goods applied for are also highly similar and could be used for the same purpose as my company's products..."

13. That completes my summary of the evidence filed in these proceedings to the extent that I consider it necessary.

DECISION

14. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

"5. - (2) A trade mark shall not be registered if because -

(a)....

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, or

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

15. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

16. In these proceedings Company is relying upon the trade mark shown in paragraph 4 above which constitutes an earlier trade mark under the above provisions. Given the interplay between the date on which Squires’ application was published i.e. 20 June 2008 and the date on which Company’s trade mark completed its registration procedure i.e. 5 February 1999, Company’s registration is subject to proof of use, as per The Trade Marks (Proof of Use, etc) Regulations 2004 the relevant sections of which read as follows:

“6A Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark in relation to which the conditions set out in section 5(1),(2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

Proof of use

17. In reaching a conclusion on this point, I must apply the same factors as I would if I were determining an application for revocation based on grounds of non-use; the relevant period for present purposes is the five year period ending with the date of publication of Squires’ application for registration i.e. 21 June 2003 to 20 June 2008.

18. The leading authorities on the principles to be applied when determining whether there has been genuine use of a trade mark are *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 and *Laboratoire de la Mer Trade Mark* [2006] F.S.R. 5. From these cases I derive the following principles:

- genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);
- the use must be 'on the market' and not just internal to the undertaking concerned (*Ansul*, paragraph 37);
- it must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);
- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);
- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);
- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);
- but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);
- an act of importation could constitute putting goods on the market (*Laboratoire de la Mer*, paragraph 25 referring to the earlier reasoned order of the ECJ);
- there is no requirement that the mark must have come to the attention of the end user or consumer (*Laboratoire de la Mer*, paragraphs 32 and 48);
- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*Laboratoire de la Mer*, paragraph 34);
- the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*Laboratoire de la Mer*, paragraph 44).

19. In addition, I will keep in mind the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 in relation to determining what constitutes a fair specification, namely:

“29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31 Pumfrey J. in Decon suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

20. The comments of Mr Justice Jacob (as he then was) in *Animal Trade Mark* [2004] FSR 19 are also relevant and read:

“20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the

description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for threeholed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made."

21. Finally, the comments of the Court of First Instance (now the General Court) in *Reckitt Benckiser (Espana), SL v OHIM*, Case T- 126/03 are also relevant where it held that:

“45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or subcategories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods

or services which are sufficiently distinct to constitute coherent categories or sub-categories.”

22. In *Pago International GmbH v Tirol Milch registrierte Genossenschaft mbH* - case C-302/07 the European Court of Justice (now the CJEU) considered the requirements for establishing a reputation in respect of a Community trade mark. They said:

“30 The answer to the first question referred is therefore that Article 9(1)(c) of the regulation must be interpreted as meaning that, in order to benefit from the protection afforded in that provision, a Community trade mark must be known by a significant part of the public concerned by the products or services covered by that trade mark, in a substantial part of the territory of the Community, and that, in view of the facts of the main proceedings, the territory of the Member State in question may be considered to constitute a substantial part of the territory of the Community.”

23. It would be anomalous if reputation in one member state were enough to satisfy the requirements of Article 9(1)(c) but use in one member state could not satisfy the use requirement.

24. The unchallenged evidence of Company demonstrates that it has used the words DEEP RELIEF in the form in which it stands registered. Although Company can also rely on approximately the last six months of 2003 and the first six months of 2008, even if one restricts the enquiry to the period 2004-2007 the approximate wholesale value of sales in the United Kingdom in that period was £2.9m. The invoices provided as exhibit DS1 indicate that the goods were sold to (what appears to be) an unrelated party, and in his statement Mr Smart explains that goods bearing the words DEEP RELIEF have been sold to major retailers including Boots, Superdrug and Sainsbury's (a comment supported by the invoices themselves). Promotional spend in the period 2004-2007 amounted to some £800k. Although Mr Smart explains that the promotional figures relate to the European Union, I note that the telephone numbers of all of the contacts at the various publications listed in exhibit DS2 appear to be British, which strongly suggests that even if not all of the promotional expenditure related to the United Kingdom, it is highly likely the majority of it did.

25. In short, I am satisfied that within the relevant period Company have made genuine use of the words DEEP RELIEF within the United Kingdom. Having reached that conclusion I must now decide what constitutes a fair specification. My first task in that respect is to decide as a matter of fact on what goods the words DEEP RELIEF have been used. The evidence provided by Company indicates that DEEP RELIEF is a gel (provided in a tube) for the treatment of muscular aches and pains in human beings. I note that in its decision in the revocation proceedings mentioned in paragraph 3 above (and on much the same evidence that has been filed in these proceedings), the Cancellation Division of the OHIM concluded (in decision 2018C) that Company had used the words DEEP RELIEF on a “medical preparation for pain relief” and as a consequence of that decision reduced Company's specification from:

Pharmaceutical, veterinary and sanitary preparations; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.

to:

Pharmaceutical or veterinary products for pain relief.

26. I also note that in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* (BL O/345/10), Mr Geoffrey Hobbs QC, sitting as the appointed person, stated:

“However, that does not appear to me to alter the basic nature of the required approach. As to that, I adhere to the view that I have expressed in a number of previous decisions. In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

27. There is nothing in Company’s evidence which suggests that its DEEP RELIEF product is for veterinary use. In fact in his statement Mr Smart says that the words DEEP RELIEF are:

“used in relation to pharmaceutical products for pain relief.”

28. In view of the evidence filed by Company together with Mr Smart’s own description of the product upon which the words DEEP RELIEF have been used, and keeping in mind the case law mentioned above, a fair specification would, in my view, be:

Pharmaceutical products for pain relief.

It is on the basis of this specification that I intend to proceed.

Section 5(2)(b) – case law

29. The leading authorities which guide me are from the CJEU (Court of Justice of the European Union): *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant -but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

(e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(h) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(j) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(k) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(l) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*

The average consumer and the nature of the purchasing process

30. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. The goods at issue in these proceedings are pharmaceutical products for pain relief and medicinal herbal extracts and medical infusion. It appears to me that the average consumer for such goods may be either a member of the general public or a medical professional such as a doctor, nurse, pharmacist, herbalist etc.

31. Insofar as Company's goods are concerned, its evidence indicates that its goods are sold in retail establishments such as Boots and Superdrug (chemists) and Sainsbury's (supermarket) and is promoted in, inter alia, a range of life style publications. As there is nothing to suggest that the goods are only available on prescription (in fact the evidence all points the other way), it suggests to me that the product will be primarily obtained by a member of the public by self selection from a shelf or from the pages of a web site (although it is possible that in a retail setting it may also be selected by a member of the public following advice from a medical professional such as a pharmacist). In summary, while I think that Company's goods will be selected primarily by visual means, I do not discount that aural considerations may also come into play. Although Company's goods are likely to be relatively inexpensive, the fact that they are to be used upon the person, combined with the fact that the average consumer will wish to ensure they are selecting a product that will most effectively treat their ailment, suggests they will pay a reasonable level of attention to their selection.

32. Turning now to Squires' goods, "medicinal herbal extracts" may be bought in a range of outlets (in both the high street and on the web) including, for example, chemists and stores specialising in such goods. They are once again most likely to be selected by a member of the general public from the shelf of a retail outlet or from the pages of a web site. While visual considerations are likely to dominate the selection process both on the high street and on the web, when considered in the context of the high street the nature of these goods is likely, in my view, to result in a not insignificant number of verbal enquiries. While the goods are likely to be relatively inexpensive, the fact that the average consumer will be selecting the goods for a specific purpose combined with the fact that the goods may need to be ingested, suggests to me that a reasonably high level of attention will be paid to their selection. That leaves the phrase "medical infusion". This appears to me to be a wide term which could include, for example,

medication or nutrients to be administered by intravenous means for which the average consumer is most likely to be a medical professional such as a doctor, nurse etc. and for which the section process is self evidently likely to be a highly considered one. However, it could also be intended as a reference to a medical herbal infusion. In those circumstances the conclusions I reached above (in relation to medicinal herbal extracts) are likely to be equally applicable to these goods.

Comparison of goods

Company' s goods (following the proof of use assessment)	Squires' goods
Pharmaceutical products for pain relief.	Medicinal herbal extracts; and medical infusion.

33. The leading authorities on how to determine similarity between goods and services are considered to be *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117 and *British Sugar Plc v James Robertson & Sons Ltd (Treat)* [1996] R.P.C. 281. In the first of these cases the CJEU accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market.
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

34. All of Squires' goods could be used for, inter alia, the relief of pain and in particular the type of muscular aches and pains upon which Company have used the words DEEP RELIEF. While the physical nature of the goods may be different, the users and intended purpose of the goods may be the same as may the method of use (Squire's goods could be used either internally or externally). Finally, the goods may be sold in the same retail outlets (chemists for example) and may be competitive to the extent that the average consumer may prefer to use a herbal remedy as opposed to a

pharmaceutical product. In short, the competing goods are in my view, similar to a high degree.

Comparison of trade marks

35. The trade marks to be compared are: **DEEP RELIEF** and **DEEP RELEEV**. The average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant components of the respective trade marks and, with that conclusion in mind, I must then go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

Distinctive and dominant components

36. Company's trade mark consists of the well known dictionary words DEEP and RELIEF presented as two words in upper case. Although the word DEEP appears before the word RELIEF, Company's trade mark does not, in my view, have a distinctive and dominant element. Rather, the words DEEP RELIEF "hang together" to create a unified whole. Similar considerations apply to Squires' trade mark. Once again it consists of two elements presented in upper case. The first word DEEP is the same as that found in Company's trade mark. Although not (as far as I am aware) a dictionary word, the second word in Squires' trade mark RELEEV is likely, in my view, to be construed by the average consumer as a clear misspelling of the word well known dictionary word RELIEVE. In short, neither parties' trade marks have, in my view, a distinctive or dominant element, the distinctiveness in both lying in the totalities.

Visual similarity

37. I have described the competing trade marks above. Both consist of two words consisting of four and six letters respectively. The first word is identical as is the first three and fifth letters of the second word. Despite the differences created by the double E and V appearing in Squires' trade mark, the competing trade marks are, in my view, visually similar to a high degree.

Aural similarity

38. Both trade marks consist of three syllables, the first two of which are identical; the third syllables differ though that difference is only likely to be noticed with careful pronunciation. However, when considered overall the competing trade marks are, in my view, aurally similar to a high degree.

Conceptual similarity

39. The Oxford Dictionary of English 2010 defines DEEP, RELIEF and RELIEVE as, inter alia:

DEEP - extending far down from the top or surface: a deep gorge | the lake was deep and cold.

2. very intense or extreme: she was in deep trouble | a deep sleep. (of an emotion or feeling) intensely felt: deep disappointment. profound or penetrating in awareness or understanding: a deep analysis.

RELIEF - 1. the alleviation of pain, discomfort, or distress: tablets for the relief of pain.

RELIEVE - 1. cause (pain, distress, or difficulty) to become less severe or serious: *the drug was used to promote sleep and to relieve pain.*

40. The meanings of the word RELIEF and RELIEVE both relate to the alleviation of pain. When considered as totalities, the concept both trade marks will send to the average consumer will, in my view, relate to the penetrative relief of pain; consequently, the competing trade marks are conceptually similar to a high degree.

Distinctive character of Company's earlier trade mark

41. I must now assess the distinctive character of Company's earlier trade mark. The distinctive character of a trade mark must be appraised first by reference to the goods in respect of which it has been registered and, second, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. In the context of a product which provides relief from pain, the words DEEP RELIEF are, at best, possessed of only a very low degree of inherent distinctive character. However, the evidence provided indicates that Company have made use of its DEEP RELIEF trade mark since 1994, use which will have improved upon its inherent credentials and which by the material date in these proceedings (some twelve years later in 2006) would, in my view, have resulted in Company's trade mark enjoying a reasonable degree of distinctiveness acquired through use.

Likelihood of confusion

42. In determining whether there is a likelihood of confusion, I need to bear a number of factors in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. It is also necessary for me to keep in mind the distinctive character of Company's earlier trade mark (as the more distinctive this trade mark is the greater the likelihood of confusion), the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

43. Earlier in this decision I concluded that: (i) the average consumer for the competing goods at issue is most likely to be a member of the public at large, who will (ii) pay at least a reasonable level of attention to the selection of the goods, and who will (iii) obtain the goods predominantly by self-selection but who may on occasion also seek advice thus bringing aural considerations into play. I have also concluded that: (iv) the competing goods are highly similar that (v) neither parties' trade marks have a distinctive and dominant component (the distinctiveness lying in the totalities), (vi) the competing trade marks share a high degree of visual, aural and conceptual similarity and (vii) Company's trade mark is, as a result of the use that has been made of it, possessed of a reasonable degree of distinctiveness acquired through use. Applying these conclusions to the matter at hand, I have no hesitation concluding that there will be a likelihood of direct confusion if Squires were to use its DEEP RELEEV trade mark on the goods for which registration has been sought, and Company's opposition based upon section 5(2)(b) succeeds accordingly.

Costs

44. Company has been successful and as such is entitled to an award of costs. Awards of costs are governed by Annex A of Tribunal Practice Notice 4 of 2007. Using that TPN as a guide I award costs to Company on the following basis:

Preparing a statement and considering Squires' statement:	£200
Preparing evidence	£500
Opposition fee:	£200
Total:	£900

45. I order Meryl J Squires to pay to The Mentholatum Company Limited the sum of **£900**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 21 day of November 2011

C J BOWEN
For the Registrar
The Comptroller-General